

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

## PCT

### WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:  
KENNETH K. VU  
22872 AVENIDA EMPRESA  
RANCHO SANTA MARGARITA, CA-92688

Date of mailing (day/month/year) **14 SEP 2004**

Applicant's or agent's file reference

**FOR FURTHER ACTION**

See paragraph 2 below

P-2836-AL

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

PCT/US04/01584

20 January 2004 (20.01.2004)

24 January 2003 (24.01.2003)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): A61B 1/32 and US Cl.: 600/206

Applicant

**APPLIED MEDICAL RESOURCES CORPORATION**

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

#### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US  
Mail Stop PCT, Attn: ISA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
Facsimile No. (703) 305-3230

Authorized officer

Kevin Shaver

Telephone No. (703) 308-0858

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Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
☐ This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material  
☐ in written format  
☐ in computer readable form
  - c. time of filing/furnishing  
☐ contained in international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims 10, 12-34	YES
	Claims 1-9 and 11	NO
Inventive step (IS)	Claims 10, 12-34	YES
	Claims 1-9 and 11	NO
Industrial applicability (IA)	Claims 1-34	YES
	Claims NONE	NO

2. Citations and explanations:

Claims 1-4, 6, 8-9 and 11 lack novelty under PCT Article 33(2) as being anticipated by Butler et al. (US 6,254,534 B1).

Butler et al. disclose a retraction device with a malleable ring member 105 and an elastomeric or flexible or elastic sleeve or "membrane" 106 fixedly attached to the outer perimeter of the ring member (Figure 5, column 4, lines 12-67 and column 5, lines 1-40).

Claim 5 lacks an inventive step under PCT Article 33(3) as being obvious over Butler et al. (US 6,254,534 B1) in view of LeVahn (US 5,080,088 A).

Butler discloses all elements of the claimed invention except for a transparent membrane.

LeVahn teaches a retractor with a transparent membrane 18 so that an organ is viewable through the membrane during surgery (col. 2, lines 6-17 and lines 53-58).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a transparent membrane in the Butler et al. device, as taught by LeVahn, to enable visualization of an organ during surgery.

Claim 7 lacks an inventive step under PCT Article 33(3) as being obvious over Butler et al. (US 6,254,534 B1) in view of Peng et al. (US 6,506,149 B2).

Butler discloses all elements of the claimed invention except for a membrane made of bias-woven or knitted fabric.

Peng et al. teach a flexible material made of a deformable metal mesh coated with an elastomeric material (col. 8, lines 53-65).

Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the Butler et al. membrane of an elastic material such as a mesh (woven material), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, herein elasticity, as a matter of obvious design choice.

Claims 10 and 12-34 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest the inventions defined by the respective claims.

Claims 1-34 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.

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**Box No. VII Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

The description is objected to as containing the following defect(s) under PCT Rule 66.2(a)(iii) in the form or contents thereof.

The use of the trademark Nitinol<sup>®</sup> is noted. However, Applicant must correct the minor typographical error of misspelling the trademark as Nitenol<sup>®</sup>.

Claims 1-34 are objected to under PCT Rule 66.2(a)(iii) as containing the following defect(s) in the form or contents thereof.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims.

## NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

### INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

#### What parts of the international application may be amended?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

**When?** Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

#### Where not to file the amendments?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

**How?** Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

#### What documents must/may accompany the amendments?

**Letter (Section 205(b)):**

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.